

#### **IV. REMARKS**

Claims 1-2 and 4-30 are pending in this application. By this amendment, claims 1, 4-8, 10, 12, 16, and 19-28 have been amended and claim 3 has been cancelled. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

##### **A. SPECIFICATION**

In the Office Action, the abstract of the disclosure is objected to because of an alleged typographical error. Applicants have amended the Specification to cure the alleged deficiency. Accordingly, Applicants respectfully request withdrawal of the objection.

##### **B. DRAWINGS**

In the Office Action, the drawings are objected to under 37 C.F.R. 1.83(a). The Office asserts that the drawings fail to show every feature of the invention specified in the claims. Office Action, p. 2. In particular, the Office asserts that the “hypertext link” must be shown by the drawings. In response, Applicants submit that Fig. 5, element 136 of the present invention represents “information access field 136 includ[ing] a hypertext link(s) that allows direct access to pertinent information.” *See* p. 19, lines 9-10 of the Specification. Element 136 of Fig. 5 represents the method(s) used to access the information required to perform the control, wherein the method(s) can include hyper text link(s). *See* p. 19, lines 6-10 of the Specification.

Accordingly, Applicants submit that the drawings show each and every feature of the claimed invention, including at least one hypertext link. (*See* claims 27 and 30.) Therefore, Applicants respectfully request withdrawal of the objection to the drawings.

### C. 35 U.S.C. §112

In the Office Action, claims 1-30 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being incomplete for omitting essential steps. Claims 1-30 are also rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In support of its rejection, the Office asserts (with respect to claim 1) that “there should be a step between (a) and (b) because it appears the Applicant is first performing tests to id the risk [and] then id risks as control point[s].” Office Action, p. 3. The Office further asserts that “the risks have already been identified in step (b) and there is no mention/step of a performing of tests to identify the risks, only that the risks are identified.” *Id.* Applicants have amended claim 1 to cure the alleged deficiency. Step 3 of claim 1 now recites “arranging information pertaining to the control points in a standard format using a template and storing the template in a computer database to provide subsequent access to the template, wherein the information comprises a set of tests to be performed by a test entity, and wherein the set of tests identify an occurrence of the risks in the business process.” The general risks of the business process are identified in step 2, while the set of tests in step 3 identify *an occurrence* of the risk. Therefore, Applicants submit that claim 1 recites all essential steps and respectfully request withdrawal of the rejection.

With respect to independent claims 7, 10, 12, 16, 19, 23, 26, and 28, Applicants herein incorporate the arguments made above with respect to claim 1. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

With respect to dependent claims 2, 4-6, 8-9, 11, 13-15, 17-18, 20-22, 24-25, 27, and 29-30, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

#### D. 35 U.S.C. 101

In the Office Action, claims 4-6, and 8 are rejected under 35 U.S.C. 101 because the claims allegedly recite a use, without setting forth any steps involved in the process, resulting in an improper definition of a process. Office Action, p. 4. Applicants have amended claims 4-6 and 8 to cure the alleged deficiency. Applicants submit that amended claims 4-6 and 8 are in proper form and respectfully request withdrawal of the rejection.

Furthermore, claims 19-28 are rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed towards non-statutory subject matter. Applicants have amended claims 19-27 in response. Applicants submit that a computer-implemented template, as disclosed by the present invention, is not equivalent to a simple pattern on a piece of paper and/or a contract between two or more persons, and therefore represents proper statutory subject matter. Furthermore, claim 28 recites, *inter alia*, “a program product stored on a recordable medium for arranging business process control point information in a template,” and therefore represents proper statutory subject matter. Accordingly, Applicants submit that claims 19-28 are directed towards statutory subject matter and respectfully request withdrawal of the rejection.

Still furthermore, the Office has given the “use of the template and the fields there on little patentable weight so long as the prior art shows 1) providing a business process 2) id the risks and 3) arranging information pertaining to risks on a template.” Office Action, p. 5.

Although it is unclear whether the Office is using the above quoted assertion as a separate basis for rejection, Applicants submit in response that claims 19-30 are distinguishable from the prior art in terms of both structure and function. As will be further discussed below with respect to “PRAM it or walk away”; Gray, Neal; Transactions of AACE International; pp: r5-48; 1998 (hereinafter the PRAM reference), Applicants submit that there is no prior art disclosure of “a computer implemented template for arranging business process control point information comprising: a test field for arranging a set of tests to be performed by a test entity, wherein the set of tests identifies an occurrence of a risk in a business process [.]” (See claim 19, and as similarly recited by claims 23, 26, and 28.)

#### E. 35 U.S.C. §102

In the Office Action, claims 1-29 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by the following: the public activities as of May 5<sup>th</sup>, 2000 of Keane Inc., the Keane Inc. website as of May 5<sup>th</sup>, 2000, and Keane Inc.’s published PRAM reference. Office Action, p. 6. Reconsideration in view of the following remarks is respectfully requested.

With respect to independent claims 1, 7, 10, 12, 16, 19, 23, 26, and 28, Applicants submit that the PRAM reference fails to disclose each and every feature of the claimed invention. In support of its rejection, the Office asserts, with respect to claims 1 and 7-10, that Fig. 3, combined with the fact that “Keane is a consultant/auditor/test entity which conducts tests and consults/audits companies risks and how to address via an ‘e-solutions strategy’/ action entity

and thus implemented on a computer and audits using a template,” teaches the third step of Applicants claim 1. Office Action, pp. 6-7. However, with respect to claim 1, Applicants submit that the PRAM reference fails to teach, *inter alia*, “arranging information pertaining to the control points in a standard format using a template and storing the template in a computer database to provide subsequent access to the template, wherein the information comprises a set of tests to be performed by a test entity, and wherein the set of tests identify an occurrence of the risks in the business process.”

Interpreting the PRAM reference only for purposes of this response, Applicants submit that the PRAM reference discloses,

“[o]nce the initial estimates exist, the estimator must make a list of all risks for the task, project, job, or proposal that is being addressed. Listen for words and phrases including, ‘That’s an issue,’ ‘I don’t know,’ ‘We assume,’ ‘I’m not sure,’ ‘I think,’ ‘I have no idea,’ or ‘We’ll figure it out as we go.’ These are a few tell-tale phrases that indicate the potential for risk.” (*See* the PRAM reference, section V.)

According to the above passage, the PRAM reference discloses a method of risk identification based on verbal communication(s) between the customer and the estimator. *Id.* Depending on the words/phrases used by the customer, the risks are identified and listed in the template. *See* Fig. 3 of the PRAM reference. However, the template in Fig. 3 does not contain, list, or arrange any of the methods/tests used by the estimator and the client to identify a specific occurrence of a risk. For example, Fig. 3 of the PRAM reference makes no disclosure of a column or metric for displaying the various verbal communication clues used by the estimator to identify risks. As such, various estimators may reach inconsistent results by using different methods of identification. These problems are magnified for a new estimator or an external estimator

unfamiliar with the verbal communication method of risk identification taught by the PRAM reference.

In contrast, the present invention discloses, *inter alia*, a method for reviewing a business process that includes a standard template for arranging business process review information, wherein the information includes a set of tests to be performed by a test entity in a test field. As recited by claim 1 (and as similarly recited by claims 7, 10, 12, 16, 19, 23, 26, and 28), the present invention discloses, *inter alia*, “arranging information pertaining to the control points in a standard format using a template and storing the template in a computer database to provide subsequent access to the template, wherein the information comprises a set of tests to be performed by a test entity, and wherein the set of tests identify an occurrence of the risks in the business process.” This allows all review information, including information for a set of tests to be performed by a test entity to identify specific occurrences of risks in the business process, to be arranged in a standard format and stored so that reviewers, auditors or the like can refer to the template(s) to accurately and efficiently perform their duties. The PRAM reference, however, fails to disclose this claimed feature. Even assuming, *arguendo*, that the PRAM reference discloses generally a template for identifying risks, Applicants submit that the PRAM reference does not disclose a template to identify whether the risk has actually occurred. Accordingly, Applicants submit that the PRAM reference fails to disclose each and every element of claim 1 and respectfully request withdrawal of the rejection.

Furthermore, Applicants submit that the PRAM reference, which fails to disclose each and every feature of the claimed invention, may not be bolstered simply by a recitation of the general business services provided by Keane Inc. The nature of Keane Inc.’s business may not be used to supplement an element absent from the PRAM reference. Unless each and every

element of Applicants claim 1 is taught by the PRAM reference, the rejection is improper. Nowhere does the PRAM reference disclose, *inter alia*, arranging information pertaining to the control points in a standard format using a template and storing the template in a computer database to provide subsequent access to the template, wherein the information comprises the set of tests to identify an occurrence of the risks in the business process. Accordingly, Applicants respectfully request withdrawal of the rejection.

With respect to independent claims 7, 10, 12, 16, 19, 23, 26, and 28, Applicants herein incorporate the arguments made above with respect to claim 1. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

With respect to dependent claims 2, 4-6, 8-9, 11, 13-15, 17-18, 20-22, 24-25, 27, and 29, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

#### F. 35 U.S.C. §103(a)

In the Office Action, claims 1-30 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over PRAM, in further view of Official Notice. Office Action, p. 9. In support of its rejection, the Office asserts that the PRAM reference discloses “all of the limitations as discussed above; the method in which nearly all consultants analyzing risk normally use and steps and considerations made (i.e., id risk, determine how to mitigate, and keep track on a template). PRAM does not discuss the use of the internet and an access field that includes a hypertext link that would allow direct access to a field as claimed.” *Id.* In response, Applicants first submit that only claims 27 and 30 recite the use of a hyper link. Accordingly, a rejection

under 35 U.S.C. 103(a) as being unpatentable over PRAM in further view of Official Notice is inappropriate with respect to all the claims (1-30). Second, Applicants submit that the PRAM reference, either singly or in combination with the Office's Official Notice, fails to disclose each and every element of the claimed invention. As discussed above, Applicants submit that the PRAM reference fails to disclose, *inter alia*, the step of "arranging information pertaining to the control points in a standard format using a template and storing the template in a computer database to provide subsequent access to the template, wherein the information comprises a set of tests to be performed by a test entity, and wherein the set of tests identify an occurrence of the risks in the business process." (See claim 1, and as similarly recited by claims 7, 10, 12, 16, 19, 23, 26, and 28.) The Office's Official Notice fails to cure this deficiency. As a result, Applicants submit that the Office has failed to make out a prime facie case of obviousness and respectfully requests withdrawal of the rejection. Finally, with regard to the 35 U.S.C. §103(a) rejection of claims 27 and 30 over the PRAM reference and further in view of Official Notice, Applicants assert that the Office's factual assertion is not properly based upon common knowledge. For example, Applicant asserts that a computer implemented template comprising an information access field for arranging background information, wherein the information access field includes at least one hypertext link that allows direct access to the background information is not obvious to one skilled in the art as asserted by the Office. Accordingly, Applicants respectfully request that the Office support the finding with references that show these features.

With respect to independent claims 7, 10, 12, 16, 19, 23, 26, and 28, Applicants herein incorporate the arguments made above with respect to claim 1. Accordingly, Applicants respectfully request that the Office withdraw its rejection.



With respect to dependent claims 2, 4-6, 8-9, 11, 13-15, 17-18, 20-22, 24-25, 27, and 29-30, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

## **V. CONCLUSION**

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

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